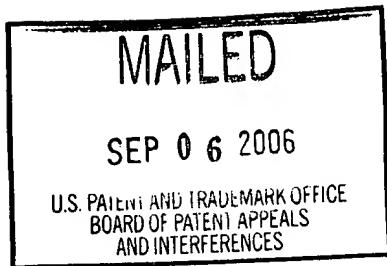


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte RODGER BURROWS

Appeal No. 2006-1910
Application No. 09/910,654

HEARD: August 9, 2006

Before KRASS, JERRY SMITH, and RUGGIERO, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-15, 17 and 18, which constitute all the claims in the application.

The disclosed invention pertains to a method and apparatus for electronically generating, storing and retrieving airline ticket agency coupon data.

Representative claim 1 is reproduced as follows:

1. A method for electronically generating, storing, and retrieving airline ticket agency coupon data, comprising the steps of:

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generating agent coupon data simultaneously with the printing of an airline ticket;

transmitting and storing said agent coupon data electronically to and in data storage apparatus;

providing each agent coupon data with an identifier;

storing said agent coupon data in a director/directory/image file arrangement; and

retrieving said electronically stored agent coupon data and printing the same in the format of an agent coupon.

The examiner relies on the following references:

Industry Agents' Handbook (IAH), Section 70.0 (2000 Ed.).

Prior art submitted by appellant relating to events involving Airlines Reporting Corporation, collectively referred to as ARC.

Claims 1-15, 17 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the prior art submitted by appellant which has collectively been labeled ARC. The basis for this rejection was quoted from a prior Board decision in making a new ground of rejection against the claims in a prior appeal of this application (Appeal No. 2004-2110, mailed January 25, 2005).

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon does support the rejection of the claims under 35 U.S.C. § 103(a). Accordingly, we affirm.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as

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evidence of obviousness. Id. 277 F.3d at 1343, 61 USPQ2d at 1433-34. The examiner cannot simply reach conclusions based on the examiner's own understanding or experience - or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kahn, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). See also In re Thrift, 298 F. 3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). These showings by the examiner are an essential part of

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complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c) (1) (vii) (2004)].

As noted above, the basis for the examiner's rejection is the same as was set forth in the previous decision by the Board in this application. With respect to independent claims 1 and 15, which are the only claims argued by appellant in the briefs, appellant essentially makes the following arguments:

- 1) The examiner and the Board misconstrued the teachings of ARC with respect to the storing of an image of the agent

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coupon and the storing of agent coupon data. Specifically, appellant argues that ARC only discloses that the image of the agent coupon is stored, and not that the agent coupon data should be optically stored.

2) An image is not data and data is not an image, as the words are commonly used.

3) The finding of obviousness based on facsimile transmission is erroneous because facsimile transmission involves transmission of an image rather than data.

4) The finding of obviousness based on multimedia network transmissions is erroneous because the prior art would still not teach the step of generating the agent coupon data as claimed.

5) IAH completely prohibits the storage of data so that the portion of IAH cited by the examiner should be interpreted to mean that the copying of an image of the coupon to an electronic storage device is prohibited.

6) The examiner has failed to establish a prima facie case of obviousness.

7) ARC teaches away from the claimed invention because ARC wanted the image of the agent coupon to be stored and does not want the agent coupon data to be stored.

The examiner responds that appellant's arguments in the brief were already considered by the Board in the previous

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decision. The examiner also notes that appellant's own specification states that data can include image format data and that claim 1 stores agent coupon data in an image file arrangement. The examiner asserts that the term "agent coupon data" is being given its broadest reasonable interpretation as required during patent prosecution. The examiner also responds that the preclusion of electronic storage by ARC does not teach away from the claimed invention because ARC is simply noting known alternative storage devices which they find unacceptable [answer, pages 4-8].

Appellant responds that IAH teaches that all supporting documents must be copied to microfiche film or to a non-magnetic optical medium, and that copying is not the same as storing because copying requires the presence of a physical document. Appellant notes that the claimed invention does not involve copying. Appellant also responds that the distinction between image and data was not addressed. Appellant reiterates that facsimile transmission or a multimedia network transmission does not transmit data which is then reconstructed as an image, but instead, transmits an image. Appellant also disputes the examiner's suggestion that appellant's specification states that an image of an agent coupon and agent coupon data are the same thing [reply brief, pages 3-6].

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We will sustain the examiner's rejection of claims 1-15, 17, and 18. We first wish to address an apparent misunderstanding of the rejection by appellant. The rejection is based on the finding that ARC teaches the claimed invention except for the storing of agent coupon data in an electronic form. In other words, the Board found that ARC teaches the storage of agent coupon data in optical form. When an airline ticket is printed for a customer, the data associated with that ticket must have been simultaneously generated in order to print the airline ticket. ARC allows an agent coupon that is representative of that transaction to be stored as an optical image of the transaction. That optical image contains data that can be used to verify the details of the transaction. It is similar to a bank checking account statement that includes images of the checks handled rather than the cancelled checks themselves. The images of the cancelled checks include data, such as payee and amount of the check, so that the account holder can verify the statement. In other words, although the data for the checks is in the form of optical images of the checks, these images, nevertheless, convey data about the checks. In the same manner, the images of the agent coupon, that are taught by ARC, also convey data about the transaction. Therefore, the point of the rejection was that it would have been obvious to the artisan

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to store the agent coupon data electronically in view of the fact that ARC already taught that the coupon data could be stored in image form. Thus, appellant's argument that there is a difference between image and data fundamentally misunderstands that an image can also convey data.

Although ARC precludes the electronic storage of the agent coupon data, this is not the type of disclosure that constitutes a teaching away. The concept of teaching away refers to a teaching that would lead the artisan to believe that the path taken would not be technically or operationally feasible. The teaching in ARC against electronic storage has nothing to do with technical or operational feasibility. ARC wanted an image of the agent coupon to replace the physical version of the agent coupon already in use. In other words, ARC wanted something they could still look at in the same manner as a physical agent coupon. The standard set forth by ARC, however, has nothing to do with obviousness under 35 U.S.C. § 103. In fact, we agree with the examiner that ARC teaches that it was known that the agent coupon data could be stored electronically, but that such storage would not be acceptable for their purposes. Thus, ARC specifically recognized that the agent coupon data could be stored electronically, but ARC chose not to permit this form of verification of the ticket information.

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Even though ARC teaches that the agent coupon data could be stored electronically even though such storage would not be in compliance with their rules, we made reference to facsimile transmission and multimedia transmission to support our finding that it was conventional in the art to transmit image data in electronic form for subsequent conversion back into image data. We simply do not agree with appellant's argument that facsimile transmission or multimedia transmission of images is image data rather than electronic data. In such communications, the images are converted to electronic signals which are reassembled into images after they are received. Since the images convey data regarding the airline ticket, the electronic form of the image also conveys data. Therefore, we still find that the image of the agent coupon represents data so that the electronic version of the image also represents data.

As noted above, our position is nothing more than a conclusion that it would have been obvious to the artisan to store the agent coupon image data as taught by ARC as electronic data because ARC recognized that such image data could also be stored electronically and because the artisan was familiar with converting image data into electronic data as required by facsimile and multimedia transmission.

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In summary, we have sustained the examiner's rejection of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-15, 17 and 18 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED



ERROL A. KRASS

Administrative Patent Judge

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JERRY SMITH

Administrative Patent Judge

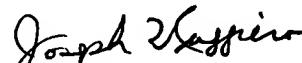
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JOSEPH F. RUGGIERO

Administrative Patent Judge

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